

REMARKS

Claims 74, 78 and 79 have been amended to the elected subject matter of the subject application as defined by the Examiner on pages 2-3 of the Office Action. Claims 73 and 75-77 have been cancelled without prejudice or disclaimer thereof and with the understanding that Applicants may pursue these claims, which are directed to non-elected subject matter, in one or more divisional applications. No prohibited new matter has been introduced by any of the claim amendments.

1. Objection to the Claims

A. Claim 76

Claims 76 and 78-81 are objected to as being of improper dependent form. More specifically, the Examiner objects to the recited scope of dependent claim 76 as being broader than the claims from which it depends.

Applicants have cancelled claim 76 without prejudice or disclaimer of the subject matter encompassed therein, effectively mooted this objection.

B. Claims 73-81

Claims 73-81 are objected to as reciting non-elected inventions.

Claim 73 has been cancelled without prejudice or disclaimer of the subject matter encompassed therein, and claim 74 has been amended to remove non-elected subject matter as defined by the Examiner on pages 2-3 of the Office Action. Applicants therefore request that this objection be withdrawn.

2. Rejection under 35 U.S.C. 112, first paragraph

Claims 78-81 are rejected as allegedly lacking enablement.

Without acquiescing to the merits of the Examiner's rejection, Applicants respectfully submit that at least in view of the amendments to the claims, which remove non-elected subject matter and thus result in a significantly reduced claim scope, that the enablement rejection should be withdrawn.

3. **Rejection under 35 U.S.C. 112, second paragraph**

Claims 73, 74, 76 and 78-81 are rejected as allegedly indefinite due to recitation in claim 73 of the specific phrases cited by the Examiner on pages 9-10 of the Office Action.

Without acquiescing to the merits of the Examiner's rejection, Applicants have, in order to expedite allowance of the subject application, cancelled claim 73 without prejudice or disclaimer of the encompassed subject matter therein. Accordingly, Applicants submit that this rejection has been effectively mooted.

4. **Rejection under 35 U.S.C. 102(b)**

A. Sudoh

Claims 73, 76 and 78 are rejected as allegedly anticipated by the cited Sudoh publication ("Sudoh") based on the asserted description in Sudoh of the chemical structures depicted on page 12 of the Office Action.

Without acquiescing to the merits of the Examiner's rejection, Applicants have cancelled claims 73 and 76 without prejudice or disclaimer of the encompassed subject matter therein, and have amended claim 78 to be dependent from claim 74, which does not encompass the Sudoh structures. Accordingly, Applicants respectfully request that this rejection be withdrawn.

B. Alterman

Claims 73, 76 and 78 are rejected as allegedly anticipated by the cited Alterman publication ("Alterman") based on the asserted description in Alterman of the chemical structure depicted on page 13 of the Office Action.

Without acquiescing to the merits of the Examiner's rejection, Applicants have cancelled claims 73 and 76 without prejudice or disclaimer of the encompassed subject matter therein, and have amended claim 78 to be dependent from claim 74, which does not encompass the Alterman structure. Accordingly, Applicants respectfully request that this rejection be withdrawn.

5. **Double Patenting Rejection**

A. Non-Provisional

Claims 73, 74 and 78-81 are rejected as allegedly obvious over claims 1-53 of U.S. Patent No. 7,354,923.

Without acquiescing to the merits of this rejection, Applicants have, in order to expedite allowance of the subject application, submitted herewith a terminal disclaimer over U.S. Patent No. 7,354,923. Accordingly, Applicants respectfully request that this rejection be withdrawn.

B. Provisional

Claims 73, 74, 76 and 78-81 are provisionally rejected as allegedly obvious over claims 1, 3, 14, 18, 19, 20, 22, 23, 24, 26-29 and 31 of allowed copending Application No. 10/837,519.


Applicants submit that the allowed claims in Application No. 10/837,519 are patentably distinct from the claims in the subject application at least for the reason that the compounds recited in the claims of Application No. 10/837,519 are necessarily tetra-substituted while the compounds recited in the claims as amended in the subject application are tri-substituted. More specifically, the compounds recited in the claims in Application No. 10/837,519 require a C₁ to C₆ aliphatic linear or branched chain substituent on the piperazine ring at the position that is designated in the subject application as unsubstituted (*i.e.*, the X₂ that is adjacent to the X₂ bearing the R₅ substituent). Applicants submit that a person of ordinary skill in the art would have no rationale for deleting the C₁ to C₆ aliphatic linear or branched chain substituent from the piperazine ring of Application No. 10/837,519 and would have no reasonable expectation that omission of this substituent from the piperazine ring would result in compounds possessing relevant (melanocortin) activity. For at least these reasons, Applicants respectfully request that this rejection be withdrawn.

6. **Conclusion**

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments and the timely allowance of the pending claims. Should an interview be helpful to further prosecution of this application, the Examiner is invited to telephone the undersigned.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
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Date: July 16, 2008

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